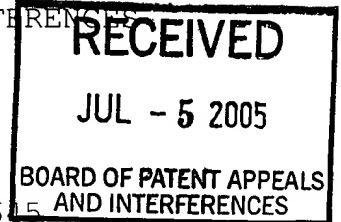


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



APPLICANT(s): Makela, J.

SERIAL NO.: 09/827,489

ART UNIT: 2615

FILING DATE: 04/06/2001

EXAMINER: Hoosain, A.

TITLE: ACTIVATION OF TELEPHONE'S OWN CALL ANSWERING
EQUIPMENT ACCORDING TO THE NUMBER OF THE
CALLING PARTY

ATTORNEY

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ATTENTION: BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT'S REPLY BRIEF

This is an appeal from the final rejection of the claims in the above-identified application. A Notice of Appeal was mailed on May 13, 2004. Thereafter, a brief was submitted with an appendix of claims attached thereto. The Examiner provided an Answer (dated May 4, 2005) to the points raised by the Appellant in the Brief.

This paper is a Reply Brief directed to points raised by the Examiner in the Examiner's Answer.

On page 18 of the Answer, the Examiner noted that a new ground of rejection is present in the Answer and that, therefore, the Appellant may proceed by reopening prosecution, or by maintaining the Appeal.

The Appellant desires to maintain the Appeal and, accordingly, is filing this Reply Brief.

APPELLANT' S ARGUMENT

First, it is desired to correct a listing of claims appearing in the Answer on page 3 at the beginning of section 10a.1, and the same listing of claims appearing at the bottom of page 8 at the beginning of section 10b.1. This listing includes both rejected claims and some claims which were said to have allowable subject matter and are not subject to this appeal. On page 3, the subsets of claims appearing in the paragraphs following the beginning of section 10a.1 are directed correctly to appealed claims, and do not mention claims which were said to have allowable subject matter. Also, with respect to the section 10b.1, subsets of claims mentioned in the following paragraphs, beginning at the top of page 9, are directed correctly to appealed claims, and do not mention claims which were said to have allowable subject matter. The claims having allowable subject matter are claims 10-11, 18-19, 21-22, 27, 31, 35 and 39, as set forth correctly on page 15 in the Answer.

The basic point made by the Examiner in the Answer, with respect to the new ground of rejection, is understood to be expressed in the top paragraph on page 10 of the Answer as follows. One may assume that peripheral devices could be combined with the telephone in Mizikowsky (U.S. patent 5,559,860). Further, accordingly to a cited decision of In Re Larson, the Examiner notes that parts that are rigidly secured together function as a single unit. The Examiner concludes that the peripheral devices in Mizikowsky, which are distributed about the telephone, could

be integrated with the telephone so as to be considered a single entity.

Possibly, the Examiner believes that all of the electronic circuits in the network of devices disclosed by Mizikovsky could be built into a single computer type chip. But Mizikovsky is not advocating that.

As will be explained in further detail, the appellant believes that the Examiner's position cannot be supported because one would not learn to integrate auxiliary equipment with a mobile station, such as a cell phone, from the teachings presented in the main reference considered alone or in combination with the other references. These references do not advocate an object of the present invention, which is to get rid of the need of any auxiliary devices, whether they be rigidly secured or not, and to let the telephone device take care of all desired functions by itself, so that the user does not need to be concerned about operating several devices simultaneously.

In the answer, beginning at page 3 at Point 10a.1 through Point 10a.5 on page 8, the Examiner quotes statements made in the Final Rejection of February 17, 2004. Thereafter, beginning on page 8 at Point 10b.1 through the first paragraph on page 15, the Examiner presents new grounds of rejection.

With respect to the Points 10a.1 through 10a.5, these points have been discussed in the Appellant's Brief, and are not discussed further in this response. It is noted that the listing of rejected claims at Point 10a.1 and also at Point 10b.1 includes claims with allowable subject matter that are not

part of this appeal. This may be verified by viewing the listing of claims of allowable subject matter set forth at Point 11 on page 15 of the Examiner's Answer.

At Point 10a.1, there is a rejection of claims under 35 U.S.C. 102(b) based on the teachings of Mizikovsky. The present application claims priority in a prior U.S. application 08/779,708 filed January 7, 1997, this date being a few months after the issue date September 24, 1996 of Mizikovsky. The chain of priority of the present application extends back to an application filed in Finland on January 8, 1996. The U.S. filing date of Mizikovsky is June 11, 1992, this being earlier than the priority date of the present application in Finland. Accordingly, the above-noted rejection under section 102(b) should be 102(a) or 102(e).

Also, at Point 10a.1, the patent number 5,327,486 is in error, this number being actually the patent number of the Wolff patent as may be verified by viewing the second line of page 3 of the answer. The correct number for the Mizikovsky patent is 5,559,860 as may be verified by viewing the bottom of page 2 of the answer. Based on the prosecution history of the present application and the preceding application, the rejection referred to at point 10a.1 is understood to be based on the teachings of Mizikovsky.

With respect to the new grounds of rejection, the text of the Answer (page 8, last two lines through page 9 at line 13) has appeared already in the Final Rejection, and has been addressed by the Appellant's Brief. A new argument of the Examiner begins on line 14 of page 9, and extends to line 10 of page 10. In the

last three lines of page 9, the Examiner admits that there is no teaching that the Mizikovsky accessory responses are sent exclusively via the mobile terminal, and that there is no teaching of an integration of the Mizikovsky accessories into the mobile device.

At the top of page 10, the Examiner argues that Mizikovsky is suggesting that the accessories are peripheral devices included in the mobile station and functioning together to process incoming calls. In support of this opinion, the Examiner cites Mizikovsky (column 3, lines 1-4 and column 7, lines 5-7).

This opinion is traversed respectfully. Mizikovsky is teaching the reverse of the Examiner's position. In column 3 at line 2, Mizikovsky teaches that a peripheral device, which is to be activated, may be included in, or coupled to the mobile device. Here, Mizikovsky is not advocating the integration of a peripheral device within a mobile station, but is acknowledging that such device might be included in or coupled to the mobile station. He then provides a listing of peripheral devices in column 3 at line 4-11, with further listing in column 7 at lines 8-30, with yet a further example of peripheral device being a cartographic display at line 52, with a pictorial listing being shown on the right side of Figure 1. A fax machine and a cartographic display are bigger than the mobile station, and any attempted physical integration of such peripheral device with a mobile station would result in a communication station that is no longer mobile.

Therefore, at most, Mizikovsky may be regarded as teaching how the electronic functions of various peripheral devices can be

employed in conjunction with the function of a mobile station to produce a useful result. Clearly, he is not teaching a person to practice the present invention because he does not differentiate between peripheral devices, in terms of being more or less desirable, and he includes in his list peripheral devices which are to be integrated physically with the mobile station. To substantiate further the Appellant's opinion that Mizikovsky does not teach the inclusion of peripherals into the mobile station, it is noted that Mizikovsky considers various peripheral devices (column 6 and lines 51-65), and begins the discussion with the teachings (line 53) that various types of accessory devices may be coupled to the mobile station. It is emphasized that Mizikovsky does not say that these devices are physically integrated with the mobile station in the sense that the Examiner understands the teaching of In Re Larson.

The remaining comments in Point 10b.1 of the Examiner's Answer, beginning with the discussion of claim 7 on page 10 through the first paragraph of page 15, are taken from the Final Rejection and have been dealt with in the Appellant's Brief.

The Examiner responds to the Appellant's argument (Point 12 of the Examiner's Answer) with an analysis of Mizikovsky intended to show that accessory items 50 are presented in Figure 1 without an interface, this being an indication that these devices are integrated with the mobile station to be an integral part thereof. In contrast, according to the Examiner's opinion, the devices identified as peripherals are connected via an interface 52 to the mobile station, and are located externally to the mobile station.

The appellant traverses this opinion of the Examiner by the following analysis. The Examiner is presuming a situation which is not described in Mizikovsky. In support of the Examiner's position, one might argue that an accessory such as the voicemail shown in Figure 1 could be constructed by digitizing a voice signal received by the mobile station, and then storing digital samples of the voice signal in a portion of the memory allocated for operation of the central processing unit (CPU) or computer 40. At a later point in time, the digitized voice signal could be read out of the memory and played via the audio output 38 to a user of the mobile station. This would fulfill the requirement of voicemail wherein an incoming voice signal can be recorded and played back at a later time. In particular, it is noted that with such a construction of the voicemail function, external bulky equipment need not be attached to the mobile station.

By way of further example, one might consider the scrambling and descrambling functions identified in Figure 1 of Mizikovsky. Scrambling and descrambling of a voice or data signal, to accomplish secure transmission, is normally accomplished by use of a computer that takes sets of samples of the digitized signal, and moves the samples out of their initial sequence for a scrambling function, this being followed later by a reinsertion of the samples into the initial sequence to accomplish a descrambling function. By use of a computer already present in the mobile station, along with the memory associated with the computer, the scrambling and descrambling functions can be accomplished without need for attachment of external bulky equipment to the mobile station.

However, it must be observed that the foregoing theoretical concepts in the construction of a voicemail function or a scrambling function are based on technology that is presumed to have been available prior to the present invention. There is no discussion of this technology in Mizikovsky, and the Examiner has not relied on any other reference for supplying this technology. It may be presumed that, if one were to build these functions by use of the computer equipment already present in the mobile station, then no interface would be necessary for driving an external device. Such argument would support the Examiner's position that the accessories 50 do not require an interface 52.

However, the Examiner then applies reverse reasoning, that the lack of a showing of such interface for the accessories 50 constitutes a teaching that the accessories 50 are integrated within the mobile station. By this reverse reasoning, it is urged that the Examiner is in error. The teaching of Mizikovsky is intended to apply independently of the physical construction of the electronic circuitry. For example, the teaching of Mizikovsky for the voicemail is intended to apply whether the voice signal be stored digitally in a computer memory, or be stored in an external tape recorder having a tape transport mechanism which is far more bulky than the mobile station (a cell phone). The small size of a cell phone may permit the phone to fit in a man's shirt pocket.

Proof of this assertion by the Appellant is found directly in the language employed by Mizikovsky. In the last paragraph of column 6, beginning at line 51, there is a discussion of the accessory devices 50. At line 53, the Mizikovsky teaches that

that various types of accessory devices 50 may be coupled to the mobile station. Now, let us compare the foregoing language with the language used to describe the peripheral devices in column 7 at lines 6-30. At line 30, Mizikovsky states that the peripheral devices are coupled to a peripheral interface 52 which, in turn, is coupled to the processor 44. Please note that the identical language is used for describing the interconnection of the accessory devices and the peripheral devices to the electrical circuitry of the mobile station. The operative words of the identical language are "coupled to". This supports the appellant's assertion that Mizikovsky intends for his invention to work equally well whether the accessories/peripheral devices be incorporated within the mobile station or be connected as external devices.

To further weaken the position of the Examiner, it is noted that, in the foregoing discussion of the construction of an accessory such as a voicemail unit or a scrambler unit in a fashion which might not require an interface, the conclusion might not always be valid. By way of example, in the use of an interface, it is noted that an interface is often needed for driving a device that operates with different signal levels (power and/or impedance levels) or signal formats (such as modulation and coding), or may be used simply to provide sufficient power to drive a long electrical cable and possibly employ a predistortion feature that compensates for distortion introduced by the connecting electrical cable. It is interesting to note that, by way of further example, the voice mail and the scrambling features might be provided by separate integrated-circuit chips that are small enough to be located within the case of the mobile station, but separate from the

computer or digital signal processor. By virtue of such separation, it may very well be necessary to include driver circuits for interconnecting the computer chip with these functional chips, such driver circuits constituting an interface. This observation shows that, contrary to the Examiner's thinking, an interface might actually be necessary even in the case of conclusion of the voicemail or scrambling circuitry within the mobile station.

In view of the foregoing argument, it is urged that the examiner, in his new ground of rejection reads more into Mizikovsky than is actually taught by Mizikovsky. If the Examiner needs extra references to teach more technology to support his position, then he should cite the necessary additional references. On the basis of the record before this Board, the Examiner has failed to justify his position that the primary reference, considered alone or in combination with other ones of the cited references, would motivate one to practice the present invention, or actually anticipates the present invention. It is urged that the position of the Examiner, as explained in his Answer, has failed to sustain the rejections under 35 U.S.C. 102 and 103.

Accordingly, it is requested that this Board find the rejected claims to contain allowable subject matter.

The Commissioner is hereby authorized to charge payment for any additional fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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7/1/05

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